

### **REMARKS**

This communication responds to the Office Action mailed on May 15, 2007.

Claims 1, 15, 22 and 52 are amended, claims 3 and 53 are canceled, and no claims are added in this communication. As a result, claims 1-2, 4-8, 13-25, 30-33, 35-45, 52 and 54-63 are now pending in this application.

#### **Claim Objections**

Claim 22 was objected to because of the following informalities: it appears that the word “an” is missing between “has” and “inside”.

Applicant has amended claim 22 with “an” added between “has” and “inside”.

#### **§112 Rejection of the Claims**

Claims 15-19 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Applicant has amended claim 15, and believes that such amendment overcomes the rejection of claims 15-19 under 35 U.S.C. § 112, second paragraph.

#### **§102 Rejection of the Claims**

Claims 1-3, 5-8, 14-15, 17-21, 24, 30, 33, 35-38, 41-45 and 52-59 were rejected under 35 U.S.C. § 102(b) for anticipation by Duncan (U.S. Patent 5,766,176). Applicant respectfully traverses this rejection for the reasons stated below.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Amended claim 1 recites (with emphasis added):

1. (Currently Amended) A resorbable contourable fixation device comprising:  
a plurality of spaced-apart fastening plates; and  
a plurality of deformable links interconnecting said fastening plates, said links having a smoothly curved arcuate shape;  
wherein said fastening plates and said links are made of a resorbable material, said fixation device being contourable in three-dimensions.

Applicant submits that Duncan does not disclose the feature “**said links having a smoothly curved arcuate shape**” as recited in amended claim 1.

The Office Action asserts that Duncan discloses that the links have a smoothly curved arcuate shape. Applicant disagrees. Duncan teaches that a plurality of links have a generally straight conformation. From for example Fig. 7 of Duncan, it can be seen that, contrary to amended claim 1, without tension, the connecting arms 34 of Duncan are in straight shape, and not in curved arcuate shape.

Referring column 6, lines 26-38 of Duncan, cited by the Office Action, with emphasis added,

“As the six (6) connecting arms 34 are drawn or wrapped around the six-arm orifice plate 32, the six (6) connecting arms 34 slightly curve or arc adjacent to the first end 72, while **the remaining portion or majority of the connecting arm 34 remains generally straight**. The connecting arms 34 remain generally straight with a slight arc, assuming the formable mesh 30 is positioned on a planar surface, because the connecting arms 34 are under tension. Should the formable mesh 30 be positioned on a concave or convex spherical surface, upon looking down atop the formable mesh 30 **the connecting arms 34 are generally straight linearly**, while they may have an arcuate or curved portion conforming to the contour of the skull 24.”

From these statements in the Duncan reference, it can be seen that, even when under tension (e.g., by rotating the screw 44) to draw connecting arms 34 around the orifice plate 32, the connecting arms 34 of Duncan still remain generally straight. Thus, the plurality of the connecting arms 34 of Duncan do not have a “smoothly curved arcuate shape” as is claimed in amended claim 1.

In addition, it appears that, when in use, the links of amended claim 1 perform differently from the connecting arms 34 of Duncan in order to conform a mesh to a bone (e.g., skull). Applicant directs the Examiner's attention to Figure 12 and paragraph [0083] of the Application, with emphasis added,

“[M]echanical interference between mutually contacting structural features of mesh 80 further contributes to and adds strength to the mesh. For example, as shown in FIG. 12, some of the normally spaced-apart **fastening plates 22 and links 24 may come into contact with each other** as shown at location 102 depending on the three-dimensional contour of mesh 80. In addition, **some links 24 may also come into contact with each other** as shown at locations 104. Accordingly, such contact between the fastener holes 22 and links 24 beneficially increases the rigidity and concomitantly the strength of the mesh 80 structure.”

However, according to the previously cited part of Duncan, when the formable mesh 30 being positioned on a spherical surface, upon looking down atop the formable mesh 30, **the connecting arms 34 are generally straight linearly**, and thus the connecting arms 34 would not come into contact with each other to increase the rigidity and strength of the mesh structure.

For at least the reasons presented above, Applicant submits that Duncan does not disclose the feature “**said links having a smoothly curved arcuate shape**” as recited in amended claim 1. Accordingly, Applicant submits that Duncan does not disclose each element of amended claim 1, thus does not anticipate amended claim 1.

Applicant has also amended independent claim 52 by adding a feature “**said links having a curved arcuate shape**” from claim 53.

Independent claims 33, 36, 41, and 52 each have a similar feature to the feature “**said links having a smoothly curved arcuate shape**” as recited in amended claim 1. Thus, the argument presented with respect to amended independent claim 1 also applies to independent claims 33, 36, 41, and 52. Applicant therefore submits that Duncan does not disclose each element of independent claims 33, 36, 41, and 52 either, thus does not anticipate these independent claims.

Claims 2, 5-8, 14-15, 17-21, 24, 30, 35, 37-38, 42-45 and 53-59, directly or indirectly, depend on independent claims 1, 33, 36, 41, or 52, thus include all the elements of claims 1, 33,

36, 41, or 52. For at least the reasons presented with respect to independent claims 1, 33, 36, 41, or 52, Applicant submits that Duncan does not anticipate these dependent claims either.

Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-3, 5-8, 14-15, 17-21, 24, 30, 33, 35-38, 41-45 and 52-59 under 35 U.S.C. § 102(b).

§103 Rejection of the Claims

Claims 4, 13, 16, 22-23, 25 and 60-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Duncan (U.S. Patent 5,766,176). Applicant respectfully traverses this rejection for the reasons stated below.

The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

From the previous discussion with respect to amended claim 1, it can be seen that Duncan actually teaches away from the feature “**said links having a smoothly curved arcuate shape**” as recited in amended claim 1, because, contrary to amended claim 1, without tension, the connecting arms 34 of Duncan are in straight shape, and are not in curved arcuate shape. Furthermore, even under tension (e.g., by rotating the screw 44 to draw connecting arms 34 around the orifice plate 32), the connecting arms 34 of Duncan still remain in generally straight shape. Thus, Duncan teaches away from the feature “smoothly curved arcuate shape” claimed in amended claim 1, accordingly does not render amended claim 1 obvious.

Amended claim 52 has a similar feature to amended claim 1, thus the arguments presented with respect to amended claim 1 also apply to amended claim 52. Claims 4, 13, 16,

22-23, 25 and 60-62, directly or indirectly, depend on independent claims 1 and 52, thus respectively include all the elements of independent claims 1 and 52. For at least the reasons presented with respect to independent claims 1 and 52, Applicant submits that Duncan teaches away from the feature **“said links having a smoothly curved arcuate shape”** as included respectively in claims 4, 13, 16, 22-23, 25 and 60-62. Accordingly, Duncan does not render claims 4, 13, 16, 22-23, 25 and 60-62 obvious.

Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 4, 13, 16, 22-23, 25 and 60-62 under 35 U.S.C. § 103(a).

Claims 31-32 and 39-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Duncan (U.S. Patent 5,766,176) in view of Barrows (U.S. Patent 5,013,315). Applicant respectfully traverses this rejection for the reasons stated below.

As discussed previously with respect to claim 1, Duncan actually teaches away from the feature “smoothly curved arcuate shape” as recited in amended claim 1. Claim 36 has a similar feature **“arcuately-shaped link”**, thus the arguments presented with respect to amended claim 1 also apply to claim 36.

Claims 31-32 and 39-40, directly or indirectly, depend on independent claims 1 and 36, thus respectively include all the elements of independent claims 1 and 36. For at least the reasons presented with respect to independent claims 1 and 36, Applicant submits that Duncan teaches away from the feature **“said links having a smoothly curved arcuate shape”** or **“arcuately-shaped link”** as respectively included in claims 31-32 and 39-40.

The Office Action does not point out, and Applicant cannot find any parts of Barrows that teach the feature **“said links having a smoothly curved arcuate shape”** or **“arcuately-shaped link”** as respectively included in claims 31-32 and 39-40. Thus, the combination of Duncan and Barrows inherently teaches away from the **“said links having a smoothly curved arcuate shape”** or **“arcuately-shaped link”** as respectively included in claims 31-32 and 39-40. Accordingly, Duncan and Barrows do not render claims 31-32 and 39-40 obvious.

Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 31-32 and 39-40 under 35 U.S.C. § 103(a).

Claim 63 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Duncan (U.S. Patent 5,766,176) in view of McKay et al. (U.S. Publication No. 2001/0001129 A1, hereinafter "McKay"). Applicant respectfully traverses this rejection for the reasons stated below.

Claim 63 directly depends on claim 1, thus includes all the elements of claim 1. For at least the reasons presented with respect to claim 1, Applicant submits that Duncan teaches away from the feature "**said links having a smoothly curved arcuate shape**" as included in claim 63.

The Office Action does not point out, and Applicant cannot find any parts of McKay that teach the feature "**said links having a smoothly curved arcuate shape**" as included in claim 63. Thus, the combination of Duncan and McKay inherently teaches away from the "**said links having a smoothly curved arcuate shape**" as included in claim 63. Accordingly, Duncan and McKay do not render claim 63 obvious.

Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claim 63 under 35 U.S.C. § 103(a).

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 373-6976 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6976

Date 12 November 07

By J. M. Kalis  
Janal M. Kalis  
Reg. No. 37,650

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of November 2007.

Zachary M. Curran  
Name

Zachary M. Curran  
Signature